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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/392,722	09/09/1999	TOSHIYA AKAMATSU	950637B	1679

23850 7590 10/08/2002

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EXAMINER

GRAYBILL, DAVID E

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 10/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/392,722

Applicant(s)

AKAMATSU ET AL.

Examiner

David E Graybill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-21,25,26 and 37-43 is/are pending in the application.
- 4a) Of the above claim(s) 17-21,25,26,37 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 20.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention.

The amendment filed 9-9-99 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. The added material which is not supported by the original disclosure is the amendment to page 15, last line.

The amendment filed 12-14-01 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. The added material which is not supported by the original disclosure is the amendment at page 15, line 14.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 39-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The undescribed subject matter is the claim 39 negative limitation, "wherein the first surface of the first electrode is not contacted with molten soldering metal

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throughout an entire manufacturing process of the integrated electronic device."

Applicant is required to cancel the new matter in the reply to this Office Action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 39-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 39 the limitation "the first surface of the first electrode" is unclear because the limitation refers to a "first surface of the first electrode" but there is no apparent previous claim-recitation of a first surface.

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. Applicant is required to provide the support in the original disclosure for the amendment filed 12-14-01, at page 15, line 14.

In the rejections infra, reference labels are generally recited only for the first recitation of identical claim language.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 39 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Behun (5143865).

At column 3, line 63 to column 4, line 62, Behun teaches the following:

39. A method for fabricating an integrated electronic device having an electric connection connecting a first electrode of a first substrate with a second electrode of a second substrate, the method comprising the steps of: forming first 18 and second 13 soldering metal bumps on the surfaces of the first 12 and second 17 electrodes, respectively, wherein a melting temperature of the first soldering metal bump is higher than a melting temperature of the second soldering metal bump; aligning the first and second soldering metal bumps to each other, and then keeping both in contact with each other; and

heating the first and second soldering metal bumps to melt the second soldering metal bump at a temperature lower than the melting temperature of the first soldering metal bump without melting the first soldering metal bump and then cooling down to solidify the second soldering metal to form an electric connection between the first and second electrodes, wherein a first surface of the first electrode is not contacted with molten soldering metal throughout an entire manufacturing process of the integrated electronic device.

41. A method for fabricating an integrated electronic device according to 39, wherein the first and second soldering metal bumps essentially consist of an alloy of Pb and Sn, wherein Pb is contained less in the first soldering metal bump than in the second soldering metal bump.

To further clarify the teaching wherein a first surface of the first electrode is not contacted with molten soldering metal throughout an entire manufacturing process of the integrated electronic device, it is noted that the first surface of the first electrode in direct contact with the first substrate is not contacted with molten soldering metal throughout an entire manufacturing process of the integrated electronic device.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Behun as applied to claims 39 and 41, and further in combination with Hideshima (5143865).

As cited, Behun teaches wherein the surface of the second electrode has adhesive tendencies to molten metal.

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However, Behun does not appear to explicitly teach the following:

40. A method for fabricating an integrated electronic device according to 39, wherein the surfaces of the first and second electrodes are made of Al and Cu, Au, Ag or Sn, respectively.

43. The method for fabricating an integrated electronic device according to 39, wherein the surfaces of the first electrodes have repellant tendencies to molten metal.

Nonetheless, at column 1, lines 31 to column 3, line 30, Hideshima teaches a process wherein a surface of a first electrode 3 has repellant tendencies to molten metal, and wherein a surface of the first electrode is made of Al or Cu. Moreover, it would have been obvious to combine the process of Hideshima with the process of Behun because it would provide the first electrodes and facilitate provision of the second electrodes.

Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Behun as applied to claims 39 and 41, and further in combination with Idaka (5473197).

Behun does not appear to explicitly teach the following:

42. The method for fabricating an integrated electronic device according to 39, wherein the first soldering metal is formed in



a trapezoidal shape by depositing a first soldering metal through a first mask.

Nevertheless, at column 5, lines 30-43, Idaka teaches this product. Moreover, it would have been obvious to combine the product of Idaka with the product of Behun because it would provide a first soldering metal.

Applicant's amendments and remarks filed 5-22-2 and 7-22-2 are addressed in the rejections supra and are further addressed infra.

Applicant states, "It is noted that the Examiner comments on page 6 of the Office Action that such 'obvious clerical error' is related to claim construction." This statement is respectfully traversed because this alleged comment is not made at page 6, or elsewhere in the Office action.

Also, applicant cites a portion of a Japanese priority document as support in the original disclosure for the amendment filed 12-14-01, at page 15, line 14. This citation is respectfully deemed to be irrelevant and unpersuasive because as set forth in MPEP 2163.07 II, "Where a non-English foreign priority document under 35 U.S.C. 119 is of record in the application file, applicant may not rely on the disclosure of that document to support correction of an error in the pending application. Ex parte Bondiou, 132 USPQ 356 (Bd. App. 1961)."

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The remaining remarks are adequately previously addressed in the record.

The art made of record and not applied to the rejection is considered pertinent to applicant's disclosure. It is cited primarily to show inventions similar to the instant invention.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

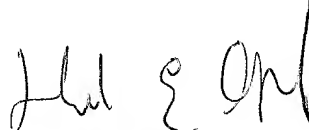
***Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to Group 2800 Customer Service whose telephone number is 703-306-3329.***

Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

The fax phone number for group 2800 is 703/308-7722.

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A handwritten signature in black ink, appearing to read "David E. Graybill", written in a cursive style.

David E. Graybill  
Primary Examiner  
Art Unit 2827

D.G.  
6-Oct-02